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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/259,757	02/27/1999	RONALD B. LEE	98627	5655
20306	7590	09/29/2005	EXAMINER	
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			TRAN, PHUC H	
300 S. WACKER DRIVE			ART UNIT	
32ND FLOOR			PAPER NUMBER	
CHICAGO, IL 60606			2666	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/259,757

Applicant(s)

LEE, RONALD B.

Examiner

PHUC H. TRAN

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46-50 and 52 is/are allowed.
- 6) ☒ Claim(s) 31 and 33-45 is/are rejected.
- 7) ☒ Claim(s) 32 and 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

\* The following claim 31 was indicated allowable by examiner in previous office action; however, these claims are unpatentable in view of new arts. Therefore, these indicated claims are withdrawn.

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 44 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Regarding to claims 44 and 51, “the lease time is less than 10 seconds” is not described in the specification in such a way to reasonably convey to one skilled in the relevant art. In the specification was discloses “in addition the lease time 142b may be set to a short enough length of time to make the use of the temporary IP address 142a unlikely. The lease time 142b is preferably from 5 to 10 seconds, however, shorter or longer lease times are possible. Because the cable modem 16 may require one or more minutes to achieve connectivity, the lease time 142b may expire, and the temporary IP address 142a may be

Art Unit: 2666

renewed many times before the cable modem 16 has connectivity.” There is nothing that teaches about the lease time is less than 10 as recited claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 34-35, and 37-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Regarding to claims 34-35 and 37-38, “wherein a temporary configuration server” is not disclosed in the independent claim 32, which was vague and indefinite because claim never recited “a temporary configuration server” before.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

Art Unit: 2666

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 31, 33, 36, 39-43, and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Woundy (U.S. Patent No. 6009103).

- With respect to claims 31, & 39, Woundy teaches a method for ensuring a connection to a configuration protocol server on a data network by a customer premises equipment via a network connection (e.g. the method for automatic allocation of resource in a network), the method comprising the steps of:

issuing a request for a customer premises equipment network address from the customer premises equipment to the configuration protocol server via the network connection (block 100 in Fig. 2a);

the network connection determining whether a connection can be made to the configuration protocol server, and if not, responding to the customer premises equipment by sending a temporary network address and a lease time to the customer premises equipment, whereby the lease time limits the time of validity of the temporary network address (blocks in Fig. 2a & b, col. 6, lines 3-33);

issuing a request to renew the temporary network address when the lease time expires (col. 6, lines 64-67); and

the network connection determining whether a connection can be made to the configuration protocol server, and if not, responding to the customer premises equipment by sending an acknowledge message (204 in Fig. 3a).

- With respect to claims 33, 36, & 40, Woundy teaches wherein the network connection comprises a communications device for connecting the customer premises equipment to a local network, the local network being connected to the data network via a network interconnection device (e.g. Fig. 1).

- With respect to claim 41, Woundy teaches wherein the communications device includes a cable modem, the local network includes a cable network and the network interconnection device includes a cable modem termination system (e.g. Fig. 1).

- With respect to claim 42, Woundy discloses wherein the configuration protocol server is a dynamic host configuration protocol (DHCP) server (e.g. Fig. 1).

- With respect to claim 43, Woundy further discloses wherein the customer premises equipment network address used by the customer premises equipment is an Internet protocol (IP) address (col. 3, lines 31-35).

- With respect to claim 45, Woundy also discloses wherein the data network includes a connection to the Internet (col. 1, lines 7-10).

#### ***Response to Amendment***

7. Applicant's arguments with respect to claims 31-45 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Allowable Subject Matter***

8. Claims 46-50 and 52 are allowed.

Art Unit: 2666

9. Claim 32 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claim 51 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gai et al. (U.S. Patent No. 6697360 B1) discloses method and apparatus for auto-configuring layer three intermediate computer network devices.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H. TRAN whose telephone number is (571) 272-3172. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2666

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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P.t  
9/26/05



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